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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,595	05/25/2006	Wolfgang von Deyn	BASF.10154WOUS	4949
45473	7590	04/30/2008		
HUTCHISON LAW GROUP PLLC PO BOX 31686 RALEIGH, NC 27612			EXAMINER BROOKS, KRISTIE LATRICE	
			ART UNIT	PAPER NUMBER
			1616	
			MAIL DATE	DELIVERY MODE
			04/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,595	Applicant(s) DEYN ET AL.	
	Examiner KRISTIE L. BROOKS	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/2/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. Claims 9-28 are pending.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 9-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15-33 of copending Application No.

10/581109.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a method for the protection of a seed comprising contacting the seeds with a compound of formula I.

Claims 15-33 of copending Application No. 10/581109 are drawn to a method for controlling non-crop pests comprising contacting the pests or food supply, habitat, breeding grounds or their locus with a compound of formula I.

The instant claims differ from the cited patent by the method of use. However, the method for controlling non-crop pests in copending Application comprises contacting the food supply or breeding grounds with a compound of formula I, and thus is not patentably distinct from the instant claims because the food supply or breeding ground can include the seeds of the instant invention. Thus, it would have been obvious to one of ordinary skill at the time of the invention to apply the compounds of formula I to seeds since application of the compounds of formula I can be applied to the food supply or breeding grounds where seeds may be present. Therefore, both applications are directed to similar subject matter wherein both methods utilize the compounds of formula I.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1616

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

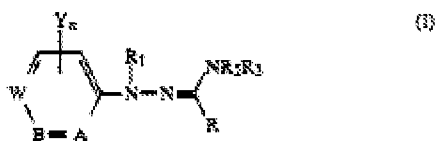
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 9-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furch et al. (US 5,420,165) in view of Nakagami et al (US 4,304,778).

Applicant claims a method for the protection of seed comprising contacting the seeds before sowing and/or after pregermination with a compound of formula I.

Determination of the scope and content of the prior art
(MPEP 2141.01)

Furch et al. teach the method of applying substituted acid amide, arylhydrazone compounds (amidrazones) to plants or soil or water in which they are growing (see column 5 lines 20-29). The substituted acid amide, arylhydrazone compounds (amidrazones) of formula I



Art Unit: 1616

are efficacious insecticidal and acaricidal agents that are useful against Coleoptera, Lepidoptera and Acarina (see the abstract, column 1 lines 20-68, column 2 lines 1-65, column 3 lines 1-24 and 49-52). The compounds are effective for protecting growing or harvested crops (see column 5 lines 20-29). The compounds are generally applied at a rate of 0.125 kg/ha to about 250 kg/ha and lower or higher rates may be used depending on the stage of plant growth, soil conditions, etc. (see column 5 lines 32-41). The compounds can be used in conjunction with other chemical control agents such as insecticides, acaricides, (see column 5 lines 43-49).

**Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)**

Furch et al. do not teach contacting a seed with a compound of formula I. This deficiency is cured by the teachings of Nakagami et al.

Nakagami et al. teach a method of protecting growing plants and seeds against insect or mite attack by applying to the seeds, plants or soil, compounds having insecticidal and acaricidal properties (see the abstract and column 2 lines 1-5). The compounds may be applied by foliage spraying, soil drenching or by coating the seeds with the insecticidal and acaricidal compounds (see column 8 lines 30-37).

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the compounds of formula I to a seed.

One of ordinary skill in the art would have been motivated to do this because Furch et al. suggest the instant compounds for application to soil and plants. Although Furch et al. do not specifically teach applying the instant compounds to seeds, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the instant compounds to seeds because it is already known in the art to apply insecticidal and acaricidal compounds to seeds as well as to soil or plants for protection against insects and mites as suggested by Nakagami et al. Thus, one of ordinary skill in the art at the time of the invention would have applied the instant compounds to any area that may be affected by insect or mite infestation for the purpose of obtaining maximal protection against said pests. Therefore, the claimed method would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed method.

Conclusion

7. No claims are allowed.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIE L. BROOKS whose telephone number is (571)272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616